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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,423	07/29/2003	Kiran K. Chada	69014-A/GJG	1805
7590 Gary J. Gershik Cooper & Dunham 1185 Avenue of the Americas New York, NY 10036			EXAMINER WEHBE, ANNE MARIE SABRINA	
			ART UNIT 1633	PAPER NUMBER
			MAIL DATE 04/01/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/630,423

Applicant(s)

CHADA ET AL.

Examiner

Anne Marie S. Wehbe

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15, 47, 102, 103 and 116 is/are pending in the application.
- 4a) Of the above claim(s) 10-15, 47, 102, 103 and 116 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-9 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's responses to the election/restriction mailed on 8/27/07 received on 9/28/07 and 12/17/07 have been entered. Please note that the examiner of record and the art unit of record have changed for this application, see concluding paragraph for details. As indicated in applicant's response of 12/17/07, the Notice of Non-compliant Amendment mailed on 11/16/07 by the previous examiner of record was sent in error as applicant's last amendment to the claims was received before the rules change of July 30, 2003. As such, applicant's original response to the restriction requirement is acknowledged to have been proper.

Claims 1-15, 47, 102-103 and 116 are currently pending in the instant application. Applicant's election of the invention of group I, claims 1-9, with traverse, is acknowledged. Applicant's traversal states that the inventions set forth as groups I-XI in the restriction requirement of 8/27/07 are not independent and therefore cannot be restricted under 35 USC 121 which allows for restriction between inventions which are independent and distinct. According to applicants the various inventions are all related as they are all directed to adipocyte-specific nucleic acids, polypeptides, and methods relating thereto. The applicant also argues that there would not be a serious burden on the examiner since in their opinion a search of the prior art for any of Groups I-XI would likely identify art for other groups.

Applicant's arguments are not persuasive. Pages 3-7 of the action mailed on 8/27/07 presents detailed reasons in accordance with 35 USC 121 and MPEP 800 as to why the various products are independent and distinct and why the various methods are independent and distinct.

Further, the applicant is reminded that various products and method groups were identified on page 7 of the 8/27/07 as related products and methods of use properly restrictable under MPEP 806.05(h), and which were further eligible for rejoinder upon allowance of the product, see MPEP 821.04. However, note that the product of group I was not indicated as being related to any of the claimed methods. Finally, it is not agreed that the search of all groups would not impose a serious search burden on the examiner. As indicated on page 13 of the 8/27/07 action, the inventions have acquired a separate status in the art in view of their different classifications, they represent recognized divergent subject matter thus requiring different fields of search. In addition, it is noted that the various inventions would raise different non-prior art issues under 35 U.S.C. 101 and/or 112. As such, the restriction requirement of 8/27/07 is deemed proper and is made FINAL.

Claims 10-15, 47, 102-103 and 116 are therefore withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 9/28/07. Claims 1-9 are therefore under consideration.

The current examiner of record finds that the elected invention, Group I-claims 1-9, requires an additional election of species requirement not set forth by the previous examiner of record. This election of species requirement is in addition to the original restriction requirement made FINAL above.

This application contains claims directed to the following patentably distinct species of mice from which tissue is to be taken for comparison:

- a) wild type mice
- b) HMGI-C -/- mice
- c) ob/ob mice
- d) HMGI-C-/- ob/ob mice

As the elected method requires comparison between two different mice, the applicant is required to select a particular combination of mice from the list of a) –d) above from which tissue is to be taken for comparison.

The species are independent or distinct because claims to the different species recite the mutually exclusive characteristics of such species. In addition, these species are not obvious variants of each other based on the current record.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed combination species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-3 and 8-9 are generic.

There is an examination and search burden for these patentably distinct species due to their mutually exclusive characteristics. The species require a different field of search (e.g., searching different classes/subclasses or electronic resources, or employing different search queries); and/or the prior art applicable to one species would not likely be applicable to another species; and/or the species are likely to raise different non-prior art issues under 35 U.S.C. 101 and/or 35 U.S.C. 112, first paragraph.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species to be examined even though the requirement may be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected species, including

any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

The election of the species may be made with or without traverse. To preserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the election of species requirement, the election shall be treated as an election without traverse. Traversal must be presented at the time of election in order to be considered timely. Failure to timely traverse the requirement will result in the loss of right to petition under 37 CFR 1.144. If claims are added after the election, applicant must indicate which of these claims are readable on the elected species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the species unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other species.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141.

Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (571) 272-0737. If the examiner is not available, the examiner's supervisor, Joseph Woitach, can be reached at (571) 272-0739. For all official communications, **the new technology center fax number is (571) 273-8300**. Please note

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that all official communications and responses sent by fax must be directed to the technology center fax number. For informal, non-official communications only, the examiner's direct fax number is (571) 273-0737. For any inquiry of a general nature, please call (571) 272-0547.

The applicant can also consult the USPTO's Patent Application Information Retrieval system (PAIR) on the internet for patent application status and history information, and for electronic images of applications. For questions or problems related to PAIR, please call the USPTO Patent Electronic Business Center (Patent EBC) toll free at 1-866-217-9197.

Representatives are available daily from 6am to midnight (EST). When calling please have your application serial number or patent number available. For all other customer support, please call the USPTO call center (UCC) at 1-800-786-9199.

Dr. A.M.S. Wehbé

/Anne Marie S. Wehbé/

Primary Examiner, A.U. 1633